

REMARKS/ARGUMENTS

Claims 1-44 were pending and variously rejected under 35 USC 103(b) in light of Leeds (US2002/0016824A1) and Macavinta ("FTC searches for spam solution"). In light of the arguments below, all of the rejections are traversed or moot.

Leeds appears to describe an e-mail system that receives and identifies spam e-mail message, based upon a number of parameters, such as an acceptance list, a blocking list, a challenge parameter, or the like. In various examples, if an e-mail message is identified as a spam e-mail message, the spam e-mail message may be put onto a blocking list (e.g. filter). This blocking list may be used by the e-mail system to filter-out the same spam e-mail messages from other user's mail boxes.

Importantly, Leeds makes no mention about sending any communication to the sender of the spam e-mail message. Further Leeds makes no mention about requesting that the sender of the spam e-mail message to stop sending e-mail messages.

The Macavinta article details some industry initiatives for regulating spammers. Two such private initiatives were called the "Internet Marketing Council" and "Direct Marketing Association." To have membership in such self-regulating organizations, the article mentions that members must give its customers a way to "opt-out" of mailing list. However, there is no disclosure about what happens if customers "opt-out", but the spammer does not honor the request. Further, no evidentiary, enforcement or monitoring mechanisms are disclosed.

The Macavinta article also describes a series of proposed pending legislation, which never became law. One such bill was to give the FTC power to "bust spammers who don't give an opt-out preference." However there is no disclosure about what happens if a spammer provides an opt-out preference, but does not honor the request. Further, any specific evidentiary, enforcement or monitoring mechanisms are lacking.

In contrast, the claims of the present invention describe a very specific computer-implement evidentiary, enforcement and monitoring mechanism that can be used to force

spammers to honor requests to refrain from sending any further spam e-mail messages. As an example, claim 1, as amended recites:

receiving a first unsolicited commercial electronic mail message initiated by an e-mail sender at an electronic mail address associated with an e-mail recipient ;

sending an electronic message to the e-mail sender, wherein the electronic message includes a request that the e-mail sender refrain from initiating any future unsolicited commercial electronic mail messages to the electronic mail address where the first unsolicited commercial electronic mail message was received;

storing an indication that the electronic message including the request that the e-mail sender refrain from initiating any future unsolicited commercial electronic mail messages to the electronic mail address was sent to the e-mail sender in a log.

These steps are illustrated in the embodiments in the specification as a reply e-mail message is automatically generated addressed to the sender of the spam e-mail message. In some embodiments, the reply e-mail message includes a request that the sender of the spam e-mail message remove a user's e-mail address from a mailing list, thereby requesting the sender of the spam e-mail message not to send any further spam e-mail messages to the user. In various embodiments, an evidentiary log is maintained indicating that the reply e-mail message was sent.

Claim 1, as amended also recites an enforcement-type action:

receiving a second unsolicited commercial electronic mail message at the electronic mail address;

automatically determining whether the e-mail sender is in violation of the request that the e-mail sender refrain from initiating any future unsolicited commercial electronic messages to the electronic mail address,

in response to the second unsolicited commercial electronic mail message and to the log; and

when the e-mail sender is in violation of the request, reporting a violation of the request that the e-mail sender refrain from initiating any future unsolicited commercial electronic messages to the electronic mail address.

These steps are illustrated in some embodiments in the specification, for example, in Fig. 11. In that figure, once a remove-request e-mail message has been sent to the sender of the spam e-mail message, that spam e-mail message and remove-request is logged, steps 1120-1130. If that spam e-mail message or subsequent spam e-mail message indicates that the sender of the spam e-mail message failed to honor the remove-request (stored in the log), the failure of the sender is reported. That failure to honor the remove-request may be brought to the attention of an ISP, steps 1160-170. Additionally, that failure to honor the remove-request may be brought to the attention of other enforcement authorities. Other types of actions are described in the specification.

Claim 1 is not obvious in view of Leeds and Macavinta. As discussed above, Leeds fails to disclose anything about any communication being sent to a sender of a spam e-mail message. Additionally, Macavinta fails to disclose anything about maintaining evidentiary data in a log, as recited in claim 1. Further, Macavinta fails to disclose any mechanism for determining whether an e-mail sender of a spam e-mail message is in violation of a request, as fully recited above, based upon such an evidentiary data log.

For the reasons described above, and others, Leeds in view of Macavinta fail to even provide an prima facie case of obviousness.

Independent claims 12, 23, and 34 are asserted to be allowable for substantially the same reasons as claim 1, and more specifically, for the limitations they recite.

Dependent claims 2-11 upon claim 1 are also asserted to be allowable for substantially the same reasons, and more specifically, for the limitations they recite.

Dependent claims 13-22 upon claim 12 are also asserted to be allowable for substantially the same reasons, and more specifically, for the limitations they recite.

Dependent claims 24-33 upon claim 23 are also asserted to be allowable for substantially the same reasons, and more specifically, for the limitations they recite.

Dependent claims 35-44 upon claim 34 are also asserted to be allowable for substantially the same reasons, and more specifically, for the limitations they recite.

Numerous other claims were amended, as illustrated above, not for the purposes of patentability, but for stylistic purposes. Merely as an example, claim 44 was amended to place the claim in a more recognizable Markush claim format. Merely as another example, claim 12 was amended to recite "e-mail senders from users [[at]] associated with user e-mail addresses" to better claim the type of association. Such stylistic amendments do not limit the scope of the claims, unless expressly argued above.

CONCLUSION

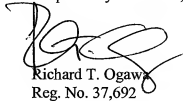
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appln. No. 10/656,502
Amdt. dated December 26, 2006
Reply to Office Action of July 25, 2006

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (650) 326-2400.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. Ogawa', with a stylized flourish at the end.

Richard T. Ogawa
Reg. No. 37,692

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: (650) 326-2400
Fax: (650) 326-2422
Attachments
SYP
60945733 v1